

Docket No: THEURER-21  
Appl. No: 09/501,251

## REMARKS

The last Office Action of August 13, 2003 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1 and 3 are pending in the application. No claims have been amended, added or canceled.

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,821,933 to Plasser et al., in view of U.S. Pat. No. 5,233,357 to Ingensand et al.

Applicants respectfully disagree with the Examiner's rejection of claim 1 and 3 under 35 U.S.C. 103(a) for the following reasons:

The present invention, as set forth in claim 1, is directed to a track surveying method which not only combines GPS measurement with a measurement using an optical beam, but sets forth particular time frames within which the GPS measurement and the optical measurement are provided. While the GPS measurement is provided to establish the position of the laser emitter **only once and only at the beginning of each measurement cycle**, the subsequent surveying method is implemented through use of a laser reference line only, independent of additional GPS measurements, thereby realizing a superior precision of the overall surveying process. It is this novel and inventive combination of GPS measurement and optical measurement in this particular sequence that is relevant here and desirous to be protected.

Docket No: THEURER-21  
Appl. No: 09/501,251

The Plasser et al. reference discloses a track liner using a laser beam gun to emit a reference beam to form a chord in the arc of a track curve, and a laser receiver, which is mounted on the liner. As described in col. 3, lines 8 to 25 and col. 8, lines 9-12, the position of the laser beam gun and the receiver are defined at the beginning of the operation in relation to fixed points. Track surveying is implemented by intermittently advancing the liner on the track curve and pivoting the laser beam gun to ascertain differences in the ordinates between two successive lining points. Thus, Plasser et al. disclosing a track surveying process, using optical measurement only.

In order to establish a case of obviousness, the Examiner applies the Ingensand reference in combination with Plasser et al. Ingensand et al. describes a surveying system using a GPS system to determine the position of a total station. The Examiner refers in particular to the passage in col. 1, lines 21-30 in Ingensand, where the advantages of a satellite position-measuring system are discussed, and notes that since Plasser et al. "teaches a time-consuming inaccurate method for determining the position of the mobile device", a person skilled in the art would be motivated to use the GPS receiver of Ingensand "for determining the *initial position*". Applicant respectfully disagrees with this line of reasoning for the following reasons.

An artisan interpreting the Plasser et al. reference as the Examiner suggested, i.e. disclosing a surveying method that is time-consuming and inaccurate, would take the teaching of Ingensand and replace the optical measurement process of Plasser et al. with the GPS system, as taught in

Docket No: THEURER-21  
Appl. No: 09/501,251

Ingensand. The Examiner hims lf underlines the benefits of the GPS system as "a well known, accurate, and convenient system for determining the exact position of devices". Thus, the Examiner opined that, had the GPS system been available at the time of the Plasser et al. invention, the artisan would have utilized the GPS system. Applying this logic by the Examiner would lead to the only conclusion and motivate an artisan only to replace the "outdated" optical measurement of Plasser et al. with the "advanced" GPS system. This, however, would not produce the instant invention but merely would result in the prior art as described on page 4, lines 3-5 of the instant specification. The error in the Examiner's line of reasoning lies in the suggestion that an artisan would be motivated to modify the optical measurement system according to Plasser et al. only as far as the initial stage is concerned. There is no teaching or suggestion supporting this interpretation. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902. Nothing in the applied prior art suggests this desirability of the modification. To the contrary, as stated above, the artisan would be motivated only to replace the whole optical measurement system of Plasser et al. with the GPS system of Ingensand et al.. There is no motivation, suggestion or teaching that would lead the skilled artisan to the invention, as set forth in claim 1.

For the reasons set forth above, it is applicant's contention that neither Plasser et al. nor Ingensand et al., nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1. None of the

Docket No: THEURER-21  
Appl. No: 09/501,251

references discloses the combination of optical measurement and GPS measurement in the particular sequence, as set forth in claim 1.

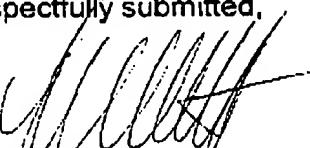
As for the rejection of the retained dependent claim 3, this claim depends on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By:   
Henry M. Feiereisen  
Agent For Applicant  
Reg. No: 31,084

Date: November 13, 2003  
350 Fifth Avenue, Suite 4714  
New York, N.Y. 10118  
(212)244-5500  
HMF:af